

REMARKS

Applicant respectfully requests that the amendments to the claims be made prior to examination of the present RCE application. Upon entry of the foregoing amendments, Claims 1-41 are pending in this application. In the amendments, independent claims 1, 11, and 24 and dependent claims 28, 30, and 31 have been amended to further clarify the claimed invention thereof over the cited prior art references. New claims 32-41 have also been added for the purposes of redefining the scope of the invention to which Applicant is entitled. Applicant respectfully requests reconsideration of the pending claims in view of the foregoing amendments and the reasons which follow.

1. Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 1-31 were rejected in view of the prior art under 35 U.S.C. § 103(a). Each specific rejection is addressed below.

1.1 Rejection of claims 1, 4-10 and 28-29 under 35 U.S.C. 103(a) based on Narasimhan et al. in view of Henson.

In the Office Action, claims 1, 4-10 and 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of U.S. Pat. No. 6,167,383 to Henson. In response to Applicant's arguments filed on January 7, 2004, the Office Action states that the preamble of independent claim 1 (as previously amended by Applicant) does not sufficiently clarify that the compliant message is regarding an environmental condition of the building because "the preamble is not considered a limitation and is of no significance to claim construction." The foregoing amendments have been made to clarify that the "complaint messages are configured to include information regarding an environmental condition of the building" is not merely a purpose or intended use of the invention but instead a limitation that results in a structural difference in the claim. Applicant submits that this amended independent claim 1 is neither expressly nor implicitly disclosed or suggested in the cited prior art combination of Narasimhan in view of Henson for the reasons stated below.

As previously explained with regard to claim 1 in Applicant's Amendment and Reply filed on January 7, 2004, Narasimhan is a general purpose e-mail forwarding system that receives e-mail messages intended for numerous recipients at a first location, processes the messages, and then forwards the messages to the intended recipients at different (remote) locations. In Narasimhan, the senders of the messages are not disclosed or suggested as being "building occupants"; the recipients are not disclosed or suggested as being "building management"; and the messages are not disclosed or suggested as being "complaints," and especially not complaints "configured to include information regarding an environmental condition of the building" (all of which limitations are recited in the body of independent claim 1 upon entry of the foregoing amendments). Henson fails to supply even one of the foregoing deficiencies in Narasimhan. Henson is directed to electronic commerce or sending messages to on-line shoppers, and makes no disclosure or suggestion of complaints regarding environmental conditions in a building. Thus, upon entry of the foregoing amendments, independent claim 1 is patentable over the cited combination of Narasimhan in view of Henson at least for the reason that the cited combination of references neither expressly nor implicitly discloses or suggests complaint messages from building occupants to building management regarding an environmental condition of the building.

Also in regard to independent claim 1, the Office Action disregarded Applicant's argument that Henson teaches away from the claimed invention. In Applicant's prior response, it was explained that Henson teaches away from the claimed invention because, even assuming the warnings therein may be for complaints, any such warnings in Henson would be displayed only to the building occupants (i.e., the senders of the complaints) rather than to building management, as required by claim 1. The Office Action disregarded Applicant's teaching away argument regarding Henson because no patentable weight was given to the limitation then at issue in claim 1. In particular, the Office Action stated that "the limitation 'generating a warning when the received complaint messages satisfy the predefined message criterion and displaying the warning to management' is an intended function of the structural elements," and that "claims directed to [an] apparatus must be distinguished from the prior art in terms of structure rather than function." According to MPEP § 2143.03, however, "all words in a claim must be considered in judging the

patentability of that claim against the prior art.” With respect to functional limitations, the MPEP further states:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used

(See MPEP 2173.05(g) Functional Limitations) (emphasis added). Accordingly, it is not proper for the Office Action to completely disregard the aforementioned teaching away argument merely because the limitation at issue may include some functional language.

Further, while the MPEP states that a 35 U.S.C. 102/103 rejection can be made where the claimed invention differs from the prior art only in terms of a claimed functional limitation which is an inherent characteristic of the prior art, it also states that “the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (See MPEP § 2112) (emphasis original). As the Office Action points to no rationale or evidence which tends to show the inherency of generating a warning when the received complaint messages satisfy the predefined message criterion and displaying the warning to building management, Applicant may distinguish and has distinguished independent claim 1 from the prior art based on this limitation.

The Office Action further states that Henson may be relied on as a basis for rejecting independent claim 1 because it is reasonably pertinent to the particular problem with which Applicant was concerned. The Office Action defines the problem as “generating a warning if the received complaint messages satisfy a predetermined criteria and display it,” and then states that “the users in Henson correspond to the management of the building.” However, the MPEP states that “a prior art reference must be considered in its entirety, i.e., as a *whole*, including portions that would lead away from the claimed invention.” (See MPEP § 2141.02) (emphasis original). Viewing Henson as a whole, the users therein cannot correspond to the management of the building as required by independent claim 1 because the warning messages generated in Henson are intended to alert *the user* when input submitted by *that same user* satisfies a predetermined criterion, rather than to alert the management of the

building, which is an entity completely different from the occupants (i.e., the users) who provide the complaint messages. Thus, as Applicant has previously stated, Henson is not reasonably pertinent to the problem as stated in the Office Action for at least the reason that it teaches away from the claimed invention.

Accordingly, Applicant submits that independent claim 1, as amended herein, is patentable over the cited combination of Narasimhan in view of Henson for at least the foregoing reasons. Additionally, dependent claims 4-10 and 28-29 are patentable over the cited combination of Narasimhan in view of Henson for at least the reason that all depend from base claim 1.

Moreover, a number of the dependent claims are patentable over Narasimhan in view of Henson for independent reasons. For example, claim 28 recites the limitation “to obtain information related to the complaint messages regarding the environmental condition of the building from the facility management system.” Claim 29 recites the limitation “a storage device that retains information related to the complaint messages regarding the environmental condition of the building obtained from the building control system.”

In the Office Action, claim 28 was rejected by reasoning that these limitations are an intended function of the structural elements, and that “claims directed to [an] apparatus must be distinguished from the prior art in terms of structure rather than function.” However, as Applicant has explained above, while the MPEP states that a 35 U.S.C. 102/103 rejection can be made where the claimed invention differs from the prior art only in terms of a claimed functional limitation which is an inherent characteristic of the prior art, it also states that “the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (See MPEP § 2112) (emphasis original). As the Office Action points to no rationale or evidence which tends to show the inherency of the limitation “to obtain information related to the complaint messages regarding the environmental condition of the building from the facility management system” in the cited prior art references, Applicant may distinguish and has distinguished claim 28 from the prior art based on this limitation. Similarly, as the Office Action points to no rationale or evidence which tends to show the inherency of the limitation “a storage device

that retains information related to the complaint messages regarding the environmental condition of the building obtained from the building control system,” in the cited prior art references, Applicant may distinguish and has distinguished claim 29 from the prior art based on this limitation.

1.2 Rejection of claims 2 and 3 under 35 U.S.C. 103(a) based on Narasimhan et al. in view of Henson and in further view of Perkowski.

In the Office Action, claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of U.S. Pat. No. 6,167,383 to Henson as applied to claim 1 and in further view of U.S. Pat. No. 5,918,214 to Perkowski. As stated above, the combination of Narasimhan in view of Henson fails to disclose or suggest the subject matter of independent claim 1, as amended herein (and hence dependent claims 2 and 3). As to Perkowski, it fails to make up for the above-noted deficiencies in Narasimhan and Henson. Perkowski is directed to a system and method for finding product and service related information on the Internet. Applicant has reviewed Perkowski and is unable to find any disclosure or suggestion therein related to complaint messages regarding an environmental condition of a building. Accordingly, Applicant submits that claims 2 and 3, as amended herein, are patentable over the cited combination of Narasimhan in view of Henson for at least the foregoing reasons.

1.3 Rejection of claims 11-16 and 30 under 35 U.S.C. 103(a) based on Narasimhan et al. in view of Official Notice.

In the Office Action, claims 11-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice. Upon entry of the foregoing amendments, the body of independent claim 11 will be amended to recite “wherein the complaint messages are configured to include information regarding an operating condition of the building.” As stated above with regard to independent claim 1, Narasimhan has nothing to do with managing complaints, and particularly not with managing complaints from occupants of a building that are configured to include information regarding operational conditions in the building. Since the Official Notice was taken only for the use of web pages on the Internet as a means of communication, it fails to make up for the above-

noted omissions in Narasimhan. Accordingly, Applicant submits that independent claim 11, as amended herein, recites a structural element that is neither expressly nor implicitly disclosed or suggested in the cited prior art combination of Narasimhan in view of Henson and thus fails to render the claimed invention obvious. Hence, it is respectfully submitted that independent claim 11, as amended herein, and dependent claims 12-16 are patentable over the cited combination of references for at least the foregoing reasons.

Moreover, as the Office Action rejected claim 30 based on the same analysis used to reject claim 28, Applicant further submits that claim 30 is patentable over the cited combination of references for the same reasons cited above with regard to claim 28.

1.4 Rejection of claims 17-19 and 22-23 based on Narasimhan et al. in view of Official Notice and in further view of Henson.

In the Office Action, claims 17-19 and 22-23 were rejected as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice as applied to claim 11, and in further view of U.S. Pat. No. 6,167,383 to Henson. As explained above, neither Narasimhan nor the Official Notice discloses or suggests the subject matter of claim 11, as amended herein. Further, the Office Action states that “the limitations recited in dependent claims 17-19 and 22-23 are covered by the limitations recited in claims 1 and 4-7 and are therefore analyzed and rejected as unpatentable over Narasimhan in view of Official Notice and further in view of Henson on the basis of same rationale.” Accordingly, as independent claims 1 and 11 have been similarly amended, dependent claims 17-19 and 22-23 are patentable over the cited combination of references for at least the reasons discussed above with regard to independent claim 1, as amended herein, and claims 4-7.

1.5 Rejection of claims 20 and 21 based on Narasimhan et al. in view of Official Notice, further in view of Henson, and further in view of Perkowski.

In the Office Action, claims 20 and 21 were rejected as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice as applied to claim 11, and in further view of U.S. Pat. No. 6,167,383 to Henson and U.S. Pat. No. 5,918,214 to Perkowski. As explained above, neither Narasimhan nor the Official Notice discloses the subject matter of claim 11, as amended herein. Further, the Office Action states that “the

limitations recited in dependent claims 20-21 are covered by the limitations recited in claims 2 and 3 and are therefore analyzed and rejected as unpatentable over Narasimhan in view of Official Notice, further in view of Henson, and further in view of Perkowski on the basis of same rationale.” Accordingly, dependent claims 20 and 21 are patentable over the cited combination of references for at least the reasons discussed above with regard to independent claim 1, as amended herein, and claims 2-3.

1.6 Rejection of claims 24-27 based on Narasimhan et al. in view of Official Notice, and further in view of Henson.

In the Office Action, claims 24-27 were rejected as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice, and in further view of U.S. Pat. No. 6,167,383 to Henson. The Office Action stated that, “[r]egarding claim 24 all the limitations are covered in claims 11, and 17 above and are therefore analyzed and rejected as unpatentable over Narasimhan in view of Official Notice and further in view of Henson on the basis of same rationale.” Accordingly, independent claim 24 is patentable over the cited combination of references for at least the reasons discussed above with regard to claim 11, particularly as amended herein, and claim 17. Additionally, it is further submitted that dependent claims 25-27 are patentable over the cited combination of references as they add further limitations to a patentable base claim.

1.6 Rejection of claim 31 based on Narasimhan et al. in view of Official Notice, and further in view of Henson.

In the Office Action, claim 31 was rejected as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice, and in further view of U.S. Pat. No. 6,167,383 to Henson. The Office Action stated that “all the limitations are covered in claims 14 and 30 above and is therefore analyzed and rejected as unpatentable over Narasimhan in view of Official Notice and further in view of Henson on the basis of same rationale.” Accordingly, claim 31 is patentable over the cited combination of references for at least the reasons discussed above with regard to claims 14 and 30.

2. New Claims

With this Amendment, new claims 32-41 are added for the purposes of redefining the scope of the invention to which Applicant is entitled. Independent claim 32, and claims 33-41 which depend from claim 32, are fully supported by the specification and contain no new matter.

3. Conclusion

Applicant earnestly believes that the foregoing amendments place the present application in condition for allowance. Accordingly, favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 08/05/2004

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